UNITES STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUYUKI MUSAKA and SHINZUKE MIZUNO

Appeal 2005-2664
Application 09/187,551
Technology Center 1700

ON BRIEF

Before GARRIS, JERRY SMITH, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the rejection of claims 1-10, 27-29, and 31-34, in accordance with 37 CFR § 41.50(a)(1).

After considering the record before us, we are convinced that the instant appeal is not ready for meaningful review. Accordingly, we hereby remand the application to the examiner to consider the following issue, and to take appropriate action.

Was the prosecution history as a whole examined in determining whether reissue recapture applies?

Reissue application 09/187,551, filed November 5, 1998, seeks to reissue U.S. Patent 5,571,571, issued November 5, 1996, based on application 08/259,584, filed June 14, 1994, as a continuation-in-part of application 08/184,331, filed January 19, 1994, now abandoned.

Additionally, U.S. Patent 6,607,790, has issued based on a related copending application 08/888,499, filed on July 7, 1997, as a continuation of application 08/538,056, filed October 2, 1995, now abandoned, which is a continuation of application 08/184,331, filed January 19, 1994, now abandoned, which is the parent application of the appeal now before us.

We note that with regard to claim amendments, the recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable. In re Clement, 131 F.3d 1164, 1469, 45 USPQ2d 1161, 1164. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. Id. Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the

cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary. Id.

We note particularly that we must examine the prosecution history as a whole to determine whether reissue recapture applies. See Wang Lab., Inc. v. Toshiba Corp., 993 F.2d 858, 867, 26 USPQ2d 1767, 1775 (Fed.Cir.1993) ("The prosecution history must be examined as a whole in determining whether estoppel applies."), and Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1482, 46 USPQ2d 1641, 1649 (Fed.Cir.1998) ("Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent's prosecution history.") .

The relevant prosecution history here includes not only the '584 continuation-in-part application but also the parent '331 application as well as the related '499 and '056 continuation applications of the parent '331 application. See Jonsson v. Stanley Works, 903 F.2d 812, 818, 14 USPQ2d 1863, 1869 (Fed.Cir.1990) (prosecution history of continuation-in-part application from same parent is relevant).

We find no indication in either the Examiner's rejection or Appellants' arguments that the prosecution history as a whole (including the claims that issued in U.S. Patent 6,607,790) was examined in determining whether reissue recapture

applies. In particular, do the '790 Patent claims that ultimately issued include the allegedly surrendered subject matter, and if not, how does this impact the alleged surrender? The record before us does not mention or address the prosecution history "as a whole" in any way. Therefore, we request that the Examiner clarify the record.

Accordingly, we *remand* for consideration of this issue.

Conclusion

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMAND

BRADLEY R. GARRIS)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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